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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,697	03/01/2002	Richard Franz	D-2998	4890
33197	7590	09/28/2006	EXAMINER	
STOUT, UXA, BUYAN & MULLINS LLP 4 VENTURE, SUITE 300 IRVINE, CA 92618			SANDERS JR, JOHN R	
			ART UNIT	PAPER NUMBER
			3735	
DATE MAILED: 09/28/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/087,697

Applicant(s)

FRANZ ET AL.

Examiner

John R. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 17 July 2006 have been fully considered but they are not persuasive. Applicant's argument for patentability relies heavily on the perceived differences between "eye screening" and a "comprehensive eye exam" when considering the prior art of record. Applicant argues that since eye screenings and comprehensive eye exams are substantially different from each other and that, since Hosoi discloses a comprehensive eye exam and Kennedy discloses a eye screening system, one of ordinary skill in the art would not be motivated to combine the references. Examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

2. In this case, since both comprehensive exams and eye screenings are known to one of ordinary skill in the art, and since both are means of ascertaining a problem associated with the eye, one of ordinary skill in the art would not be precluded from applying methods and systems disclosed for one type of exam to the other, especially in the instant case where remote examination is disclosed by both references and is a critical feature of each reference. Though eye screenings generally do not provide a prescription, providing a prescription is nevertheless a desired result, if not *the most desired result*, of testing the eye. Optical testing and subsequent

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correction using the results of said testing is the express purpose of ophthalmology in general. Thus, one of ordinary skill in the art would not be precluded from combining the teachings of Hosoi and Kennedy merely on the basis that Kennedy does not expressly disclose providing a prescription.

3. Applicant further argues that Hosoi discloses a plurality of identical eye exam units. However, Hosoi is provided for the disclosure of a plurality of eye examination *devices* at an eye examination location, not a plurality of eye examination units. Hosoi clearly discloses a plurality of different eye exam devices including a subjective refractive power measuring device 2, a target chart presenting device 4, an objective refractive power measuring device 6, and a lens meter 7 (col. 2, lines 55-67).

4. Applicant further argues that since Hosoi and Kennedy do not disclose a diagnostic center including no eye examination devices, the references teach away from the instant invention. Examiner respectfully disagrees. Examiner reapplies the rationale presented in the Office Action dated 28 July 2005 with regard to “remote examination” and obviousness:

5. It may be of use to explore the broadest interpretation of the limitation *remote* in view of the general knowledge of the art. With the advent of computer networking and Internet communications, the ability to transmit data substantially instantaneously across large distances has redefined the concept of *remote* operation. It would be to one of ordinary skill in the art that a remote communication could equally apply to a communication sent across an ocean, from coast to coast, across town, between rooms in a building, or even between computers located in the same room. In truth, the instant specification states, with regard to the remote exam module and the diagnostic center, “The examination site is generally remote from the diagnostic center,

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however it can be appreciated that the remoteness of the location may comprise the distance of a room, or may include a distance of many thousands of miles” (page 4, first paragraph).

Obviously, Applicants are aware of the broad interpretation of *remote* and how it applies to telecommunications.

6. Thus, not only is the definition of what constitutes a “diagnostic center” with respect to space and locality called into question, but also how a limitation such as “the diagnostic center including no eye examination devices” can be novel over the prior art, since it would be equally obvious, based on Applicant’s own admissions of the interpretations of “remote,” to have different elements of an eye examination system (testing, diagnosis, etc.) be in the same or different locations.

7. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**8. Claims 34-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosoi in view of Kennedy, both of record.**

9. Re claims 34, 37-38, 41, 44: Hosoi discloses an eye examination telecommunication system comprising multiple remote exam modules **100**, each with a plurality of different examination devices, that are remotely operated by a controller **3** located at a separate remote module (col. 1, line 37 - col. 2, line 24). The plurality of different examination devices includes a subjective refractive power measuring device **2**, a target chart presenting device **4**, an objective refractive power measuring device **6**, and a lens meter **7** (col. 2, lines 55-67). Hosoi discloses the diagnosis of refraction information as well of the use of a display screen to perform a visual acuity test, including determining information relating to astigmatism axis and degree (col. 5, lines 17-33), inherently including information regarding the topography of the cornea. The separate remote module acts as the practitioner's operating center and includes a database for storing test data and an exam console (col. 3, lines 20-26). Based upon the disclosed exam modules and their enablement of remote operation, Hosoi obviates a method of examining an eye at an examination location using a plurality of ophthalmic diagnostic devices and subsequently transmitting the results of said exam to a remote diagnostic center for diagnosis and prescription by a skilled practitioner.

10. Hosoi discloses the use of a printer for outputting the results of measurement at the remote diagnostic center (col. 6, lines 10-16). Hosoi does not expressly disclose the method step of providing a diagnosis and prescription to the patient prior to the patient leaving the exam module, yet it would be obvious to one of ordinary skill in the art that the printer disclosed by

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Hosoi could be used to provide the patient with a prescription, since obtaining a prescription of the patient is the express purpose of the exam modules disclosed by Hosoi and since it is common practice to provide a patient with the results of an eye examination prior to the patient leaving the exam site.

11. Re claim 35: Hosoi discloses displaying images corresponding to the transmitted eye examination data (paragraph bridging col. 5-6).

12. Re claim 36, 42 and 45: Hosoi discloses real-time teleconferencing (col. 3, lines 52-55; col. 6: 41-50).

13. Re claim 43: Hosoi discloses a public communication network **18**, which one of ordinary skill in the art would interpret as a local and/or external Internet connection.

14. Re claim 46: Hosoi discloses transmission of objective and subjective test data (col. 5, lines 34-61).

15. Re claims 39-40 and 47-50: Hosoi discloses the above limitations but does not expressly disclose a questionnaire for patient history data or a touch-screen or voice recognition software for patient data entry. Hosoi also lacks a disclosure of web-based patient information database and retrieval.

16. Kennedy discloses a system and method for eye screening (FIG. 7) wherein a remote exam module (composed of a device to record corneal and retinal reflections, a data entry device, and a control system) collects eye images from the patient. This information is transmitted to the central analysis facility via a communication link (col. 6, line 57 - col. 7, line 6). The central analysis facility comprises a record database and means for displaying the images for skilled

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specialists (col. 2, line 47- col. 3, line 10; col. 7, line 31- col. 8, line 11). Kennedy discloses creation and retrieval of examination records (col. 7, lines 14-21).

17. Kennedy discloses remote data entry via a touch screen and/or voice recognition (col. 8, lines 12-38) and a questionnaire (col. 14, lines 2-5). Kennedy discloses posting relevant patient information on the web (col. 7, lines 2-6). At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the exam modules of Hosoi to include a questionnaire and a touch screen or voice recognition unit, as taught by Kennedy, in order to collect patient information prior to an examination. It would further be obvious to one of ordinary skill in the art to modify Hosoi to include a remotely located and/or web-based patient database, as taught by Kennedy, in order for easily facilitated information retrieval from any Internet-enabled workstation in any remote location.

### *Conclusion*

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Sanders whose telephone number is (571) 272-4742.

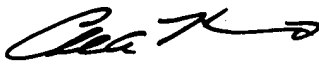
The examiner can normally be reached on M-F 10:00 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JRS

20 September 2006

  
Charles A. Marmor, II  
SPE, Art Unit 3735